

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 26, 28 and 42 are amended. Claims 58-86 have been withdrawn by the Examiner as directed to an unelected invention. Claims 1-57 are now pending in view of the aforementioned withdrawals.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments to the claims and the following remarks. For the convenience and reference of the Examiner, the remarks of the Applicant are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicant notes that the amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

### **II. Objection to Claim 28**

The Examiner has objected to claim 28. Applicant respectfully submits that in view of the amendment to claim 28 set forth herein, the objection has been overcome and should be withdrawn.

### **III. Rejection of Claims 1-9, 12-21 and 24-25 under 35 U.S.C. § 102(b)**

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure ("MPEP") § 2131.*

The Examiner has rejected claims 1-9, 12-21 and 24-25 under 35 U.S.C. § 102(e) as anticipated by US 6,198,633 to Lehman et al. ("*Lehman*"). Applicant respectfully disagrees however and submits that for at least the reasons set forth below, the rejection should be withdrawn.

In rejecting independent claims 1 and 14, from which the remainder of rejected claims 8-9, 12-13, 15-21 and 24-25 depend, the Examiner has asserted that *Lehman* discloses “a host board (50) ... having a set of openings (figures 3-4) ... a set of connectors (connectors mounted on the host board 50)... each opening in the set of openings being aligned with at least two connectors from the set of connectors (figures 1, 3-4) ... the each opening configured to accept two modules (3u) of a first form factor [and] ... further configured to accept a single module (6u) of a second form factor ... (figures 6a and 6b).”

Notwithstanding the assertions of the Examiner, Applicant respectfully submits that the Examiner has failed to identify, with any particularity whatsoever, where the “openings” recited in the claims are purportedly found in the “host board 50” of *Lehman*. Instead, the Examiner simply relies on vague references to Figures 1, 3 and 4 of *Lehman* as a basis for the rejection. Moreover, the Examiner has cited nothing from the text of *Lehman* in support of the contention that the “host board 50” defines “openings” such as are recited in claims 1 and 14. Consonant with the foregoing, Applicant further respectfully submits that the Examiner has failed to establish that *Lehman* teaches or suggests a “host board” configured such that “*each* opening in the set of openings being aligned with at least two connectors” (emphasis added) as the claims require.

The rejection of the Examiner lacks an adequate basis for other reasons as well. For example, Figures 6a and 6b referred to by the Examiner provide virtually no information as to backplane 50 (indeed, it is not even clear if backplane 50 is present in those figures, in part because the numeric designator 50 is not visible), much less disclosing “openings” that are “each configured to accept two modules of a first form factor” and “a single module of a second form factor,” as the claims require. Moreover, the Examiner has cited nothing from the text of *Lehman* in support of the contention that the “host board 50” defines openings configured and arranged such as those recited in the claims. Rather, it appears that the rejection of the Examiner is based on nothing more than vague assertions and speculation as to the purported disclosure of *Lehman*.

Finally, while the Examiner has cited Figures 6A and 6B of *Lehman* in support of the contention that the “host board 50” includes openings “configured to accept a single module (6u) of a second form factor,” Applicant notes that the Examiner has made no citations whatsoever to *Lehman* in support of the contention that the aforementioned “openings” are also “configured to accept two modules of a first form factor,” as the claims require. In this regard, Applicant submits that mere assertions regarding the disclosure of a reference, without more, are inadequate to establish anticipation.

In view of the foregoing discussion, Applicant respectfully submits that the Examiner has not established that *Lehman* anticipates claims 1-9, 12-21 and 24-25, at least because the Examiner has not shown that each and every element as set forth in the claim is found in *Lehman*, and because the Examiner

has not shown that *Lehman* discloses the identical invention in as complete detail as is contained in the claim, or shown that *Lehman* discloses the arrangement required by the claims. Applicant thus respectfully submits that the rejection of claims 1-9, 12-21 and 24-25 should be withdrawn.

**IV. Rejection of Claims 10-11, 22-23 and 26-57 under 35 U.S.C. § 102(b)**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP § 2143*.

**a. claims 10-11 and 22-23**

The Examiner has rejected claims 10-11 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of US 6,304,436 to Branch et al. ("*Branch*"). However, to the extent that the rejection of claims 10-11 and 22-23 is based on the characterization of *Lehman* advanced by the Examiner, Applicant respectfully submits that such rejection lacks an adequate basis for at least the reasons set forth at III. above. In view of the foregoing, Applicant respectfully submits that the rejection of claims 10-11 and 22-23 should be withdrawn.

**b. claims 26-57**

The Examiner has rejected claims 26-57 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of *Lehman*, *Branch*, US 6,166,917 to Anderson, and US 6,047,172 to Babineau et al. Applicant respectfully disagrees however and submits that for at least the reasons set forth below, the rejection should be withdrawn.

By this paper, Applicant has amended claims 26 and 42, from which claims 27-41 and 43-57 respectively depend, to recite "a set of slots defined in the host board; each slot from the set of slots open to an edge of the host board" and "a set of slots defined in the host board; each slot from the set of slots located along an edge of the host board such that said each slot is open to said edge," respectively. Support for these amendments can be found in the specification at, for example, page 2 (first 3 lines of last paragraph), and page 8, lines 1-9. In contrast, the Examiner has not established that any of the cited references teach or suggest such a set of slots in combination with the other limitations of the rejected claims. Thus, even if the references are combined in the purportedly obvious fashion advanced by the Examiner, the resulting combinations nonetheless fail to include all the limitations of the rejected claims.

In view of the foregoing, Applicant submits that the Examiner has not established a *prima facie* case of obviousness with respect to amended claims 26 and 42, and their respective dependent claims 27-41 and 43-57, at least because the references, when combined in the purportedly obvious fashion, nonetheless fail to include all the limitations of the rejected claims. Applicant thus respectfully submits that the rejection of claims 26-57 should be withdrawn.

**V. Docket Number**

Applicant respectfully notes that the Office Action incorrectly references Attorney Docket No. "9775-074-999." Pursuant to the Change of Attorney Docket Number filed in this case on June 9, 2003, the correct docket number for this case is 15436.253.45. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communication from the USPTO reference docket number 15436.253.45.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-57 is in condition for allowance. Therefore, allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 12<sup>TH</sup> day of January, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter F. Malen Jr.', is written over the typed name and title.

Peter F. Malen Jr.  
Attorney for Applicants  
Registration No. 45,576  
**Customer No. 022913**  
Telephone: (801) 533-9800